

Appl'n. No. 08/941,174
Arndt. Dated July 18, 2003
Reply to Office Action of July 8, 2003

REMARKS/ARGUMENTS

This amendment is believed to be in compliance with *Amendments in a Revised Format Now Permitted*, 1267 Off. Gazette 106. A listing of all claims in the application, including cancelled claims, has been included, and is referenced below.

Claims 5, 8-12 and 17-24 are pending for consideration. Claim 8 has been amended and claim 24 is a new claim. Claims 1-4, 6, 7 and 13-16 have previously been cancelled.

Claim 8 has been amended to correct a typographical error and for clarification of the claimed subject matter.

Rejections Under 35 US 103

Claims 5, 8-12 and 17-22 have been rejected as unpatentable over Gateway 2000 Press Release, 08/21/96 (Gateway 2000 Press Release), in view of US Patent 5,191,423 (Yoshida), in view of "How to Use Microsoft Windows NT4 Workstation, Jacquelyn Gavron and Joseph Moran, Ziff-Davis Press, 1996 (Gavron). The rejection is respectfully traversed.

(A copy of the Gateway 2000 Press Release in the undersigned attorney's file record of this application accompanies this paper for verification by the Examiner because of difficulties in correlating comments in the Office Action with this reference. It is also noted that there are two other earlier cited internet articles "The Big-Tube PCTV", 08/21/96, Ziff-Davis and "Destination Features", 08/21/96, Gateway 2000 Inc." It is unclear whether or not these additional internet articles are relied on in the Office Action.)

The inadequacy of the set of references relied on is conceded by what appear to be mischaracterizations or assertions in the Office Action that various features are "(well) known in the art". For example, with respect to Gateway 2000 Press Release, it is asserted in the Office Action "*The Gateway 2000 PCTV necessarily enables the user to place the system in one of a PC or TV mode.*" And then "[*The disclosure*] . . . teaches that at least Windows 95 may be pre-installed on the PCTV." Whereas In the copy of the Gateway Press Release in the possession of Applicants' attorney, no such disclosure is seen. (Such a reference does occur in an earlier cited

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internet article "The Big-Tube PCTV", May 28, 1996.) . And, "It was known that Windows 95 included the Microsoft Internet Explorer, IE4 package. The Internet Explorer, IE4 comprises multiple pre-loaded URL's at least to the Microsoft web site." "Official Notice is taken that . . . it was well known to store EPG within a TV-computing device." (But in relation to claim 9 it is asserted in the Office Action ". . . page 3 of Gateway 2000 Press Release teaches downloading an EPG." – no specific disclosure is seen ion page 3 but page 3 of "Destination Features" includes the statement: "Subscribe: Option to subscribe to the TV Guide on-line service". The sated grounds of rejection of claims 8 and 9 are thus unclear.) Consequently, this ground of rejection should be withdrawn or the source of each of the features asserted in the Office Action as present in Gateway 2000 Press Release should be clarified so that a properly informed evaluation of and response to these grounds of rejection can be made.

Beyond that, the necessity in the Office Action to supplement the disclosures of at least three disparate references with assertions that several still missing features were "known" or "well known" exposes the inadequacy of the rejections to state a *prima facie* case of obviousness. With respect, the Examiner is reminded of the necessity, to establish a *prima facie* case of obviousness, to make an objective factual showing that the combination of prior art references relied on not only includes all of the claimed elements, but also a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention considered as a whole to have been obvious in the light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985) See MPEP 2142. In determining the differences between the prior art and the claims, the question under 35 US 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 2d 871 (Fed. Cir. 1983); *Schenk v. Nortron Corp.*, 218 USPQ 698 (Fed. Cir. 1983) See MPEP 2141.02. Even if the cited references were to disclose (which as discussed above, they do not) that all elements of the claimed invention were individually known in the art, that is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pt. App. & Inter. 1993); *In re Kozab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) . The level of ordinary skill in the art cannot be relied upon to provide the suggestion to combine references. See MPEP 2143.01. Yet that is precisely what

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has been relied on in each of the three paragraphs in Section 4 of the Office Action applying Gateway 2000 Press Release against claim 8, and by implication against claims 8-12 and 17-23. The rejection of claims 5, 8-12 and 17-23 should be withdrawn on this basis alone.

Yoshida's disclosure does not extend beyond presenting a user with a list of names of broadcasting stations based solely on user input of an initial letter of a broadcasting station (col. 1, line 55 to col. 2, line 6). Yoshida teaches that when a list of channel names having a particular initial letter is displayed, user operation of a "CH" key is required to move a cursor from the first displayed name to the next, and so on until a desired channel is selected. When 5 seconds have passed without the "CH" key being pressed for channel up, the channel is fixed, and the operation is completed. The Office Action recognizes Yoshida "*only teaches entering the first alphanumeric key actuation*", and speculates, subjectively, ". . . one of ordinary skill in the art would have been motivated to sort a list of stations using more than just the first alphabet (sic), at least in order to provide the user with a more narrow search." No such suggestion or motivation is provided by Yoshida and, again, the Office Action appears impermissibly to rely on the level of skill in the art to provide a subjective and speculative conclusion that Yoshida could have been combined with Gavron in attempt to remedy the admitted shortcomings of Yoshida. In one mode (Item 3 cited in the Office Action) Gavron teaches: "To search for information by topic click on the Index tab, which displays an index like the one at the back of a book. In the blank space at the top of the dialog box, type in either the entire word or just the first few letters of the word you are interested in. As soon as you start typing, the Index list jumps to that topic." (The Office Action asserts ". . . since the user entered the word, "folders" at least two entries are listed that include that instant sequence of alphabets (sic)." Such disclosure is not apparent from the copy of this reference available to the undersigned attorney. If this reference is to be relied on, receipt of a reasonable quality enlarged version of at least the portions of page 7 being relied on would be appreciated.) Reference in Gavron to "folders" is seen in Items 5 and 6 of Gavron, directed to locating information in an extensive database providing "HELP" support for a Windows NT4 Workstation and which initially requires user identification of one of a plurality of access modes, one of which is a word search mode ("Find") "which generates a list of *all* words in the entire help system." (Gavron, Item 5; emphasis in original.) Gavron continues "Now just type the word (or words) that best describes what you

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need help with . - In this example it's folders." (Gavron, Item 6.) Items 5 and 6 on their face are not seen to be pertinent to the claimed invention. Nor is it clear how the Office Action proposes that Gavron Item 3 be utilized in conjunction with Yoshida. Yoshida is not concerned with "topics" and does not provide a "topical index" which is the starting point for Gavron's search activity in Item 3. Nor does the Office Action provide any objective, fact based evidence as to how Yoshida or Gavron suggest that Gavron might be modified to adapt to Yoshida without adversely affecting Gavron's suitability for its intended purpose, as described at Item 3. No support is seen in Yoshida or Gavron for arbitrary selection in the Office Action of an isolated feature from Gavron, although such motivation may be apparent from applicant's claimed invention – but that is an impermissible hindsight basis for identifying motivation.

Withdrawal of the rejection of claims 5, 812 and 17-22 on the basis of Gateway 2000 Press Release, Yoshida, Gavron together with various individual elements asserted to have been within the knowledge of a person of ordinary skill in the art is respectfully requested as failing to establish a *prima facie* case of obviousness.

The rejections of claims 10, 11 and 12 again rely on assertions of "obviousness" impermissibly based on the individual items being "well known" in the art, and are traversed for the same reasons discussed above in respect of this type of rejection. The pertinent consideration is to be directed to the invention considered as a whole – i.e. the element(s) set forth in claims 10, 11 and 12 each considered in combination with all of the features of claim 8.

In the rejection of claim 20 is stated "... the claimed features of a computer system emulating a TV system which corresponds with subject matter of claim 8, are likewise analyzed." With respect, while claim 20 includes recitation explicitly directed to "channel macros", claim 8 does not include similar explicit recitation. Consequently, the grounds rejection of claim 20 are respectfully traversed as incomplete as well as for similar reasons advanced in respect of claim 8.

In rejecting claim 23, yet a further reference – US Patent 6,202,212 (Sturgeon) has been added to Gateway Press Release, Yoshida and Gavron and the various assertions that additional

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individual features of the claims not disclosed by the references were (well) known in the art, and correlated with speculation of "obviousness" based on a "desirable benefit of presenting the viewer with an unencumbered view of the TV program" but no support of suggestion or motivation in the prior art. Claim 23 has been rejected based on assertions that individual differences between elements of the claimed combination and individual references would have been "obvious" whereas, as discussed in detail in relation to the rejection of claim 8, the question under 35 US 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious, and no objective, fact based evidence has been presented in the Office Action in that respect.

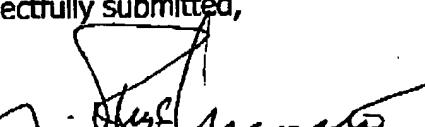
New claim 24 develops the subject matter set forth in claims 8 and 19 and is patentable for at least similar reasons set forth above in respect of those claims.

In summary, it has been shown in the above discussion that the grounds of rejection set forth in the Office Action fail to meet the criteria set forth in MPEP 2143 necessary to establish *prima facie* case of obviousness. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991) – see MPEP 2143 (emphasis added). With respect, the grounds of rejection as advanced in the Office Action fail to satisfy this standard.

Favorable consideration and early allowance of the application are solicited. If telephone discussion of any matter might assist expediting prosecution of this application, a telephone call to the undersigned attorney at 972-862-7428 would be appreciated.

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Respectfully submitted,



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